

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCE

Ex parte JAMES S. MAGDYCH,
TARIK RAHMANOVIC, JOHN R. MCDONALD,
BROCK E. TELLIER, ANTHONY C. OSBORNE
AND NISHAD P. HERATH

Appeal No. 2006-0914
Application No. 09/895,508¹

ON BRIEF

MAILED

MAY 31 2006

PAT & T.M OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before HAIRSTON, JERRY SMITH and SAADAT, Administrative Patent Judges.

SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1, 4-6, 9-12, 15-17 and 20-35. Claims 2, 3, 7, 8, 13, 14, 18 and 19 have been cancelled.

We reverse.

¹ Application for patent filed June 29, 2001.

BACKGROUND

Appellants' invention is directed to a method and system for performing local risk-assessment scanning for detecting local threats from a remote location. An understanding of the invention can be derived from a reading of exemplary independent claim 1, which is reproduced as follows:

1. A method of remotely detecting vulnerabilities on a local computer, comprising:
 - a) installing an agent on a local computer;
 - b) receiving encrypted commands for executing a risk-assessment scan from a remote computer utilizing a network;
 - c) decrypting the commands on the local computer utilizing the agent;
 - d) processing the commands on the local computer utilizing the agent; and
 - e) performing the risk-assessment scan on the local computer in accordance with the processed commands to remotely detect local vulnerabilities on the local computer;
wherein the agent includes a plurality of risk-assessment modules;
 - wherein the commands execute the risk-assessment modules in a specific manner that is configured at the remote computer;
 - wherein the commands each indicate at least one of the risk-assessment modules;
 - wherein the commands are processed by extracting parameters associated with the commands, and executing the risk-assessment modules indicated by the commands utilizing the associated parameters.

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The Examiner relies on the following references in rejecting the claims:

Smid et al. (Smid)	4,386,233	May 31, 1983
Orchier et al. (Orchier)	6,070,244	May 30, 2000
Shostack et al. (Shostack)	6,298,445	Oct. 2, 2001 (filed Apr. 30, 1998)

Claims 1, 12 and 23-27 stand rejected under the second paragraph of 35 U.S.C. § 112 as being indefinite.

Claims 1, 4-6, 9, 10, 12, 15-17, 20, 21 and 23-35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shostack and Orchier.

Claims 11 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shostack, Orchier and Smid.

Rather than reiterate the opposing arguments, reference is made to the briefs (filed July 7, 2005 and October 13, 2005) as well as the final rejection and answer (mailed March 1, 2005 and September 12, 2005) for the respective positions of Appellants and the Examiner. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the briefs have not been considered (37 CFR § 41.37(c)(1)(vii)).

OPINION

With respect to the rejection of the claims under the second paragraph of 35 U.S.C. § 112, the Examiner identifies the term "configured at the remote computer" as indefinite and states that it is unclear as to whether the module or the execution of the modules is configured (answer, page 4). In response, Appellants assert that it is the manner of execution of the modules that is being configured (brief, page 19). Appellants further argue that although the commands are processed on the local computer, they execute the risk-assessment modules by utilizing the agent on the local computer (reply brief, page 2).

Upon a careful review of the claim language, we find that it is clear from the claim language as a whole that it is the manner in which the commands execute the risk-assessment modules that is configured. "The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope." In re Warmerdam, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). We agree with appellants and find that the specific element that is configure is sufficiently defined, and would reasonably apprise those skilled in the art of the scope of these limitations. Accordingly, we will not sustain the

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rejection of claims 1, 12 and 23-27 under the second paragraph of 35 U.S.C. § 112.

Turning now to the 35 U.S.C. § 103 rejection of claims 1, 4-6, 9, 10, 12, 15-17, 20, 21 and 23-35, we note that the focus of Appellants' arguments is that, instead of the claimed "commands execute the risk-assessment modules in a specific manner that is configured at the remote computer," an authorized local user in Shostack configures the modules (brief, page 10). In response, the Examiner further relies on the teachings in Shostack related to automatically updating the information about the security attacks (col. 2, lines 49-54) and asserts that these pushed updates are the same as configuring the modules by the remote location (answer, page 6). Appellants argue that Shostack's distributing database updates is not the same as the claimed locally installed agent that receives commands for executing the modules from a remote computer (reply brief, page 4). Appellants further point out that an icon on the local computer enables the user to locally configure the modules in Shostack (col. 12, lines 55-57) which is the opposite of the claimed requirements (id.).

We agree with Appellants that automatic updates provided to the local computer are not the same as the claimed commands

executing the risk-assessment modules in a specific manner that is configured at the remote computer. Specifically, configuring the modules by the local user in Shostack (col. 12, lines 55-57) indicates that any configuration of the modules and the command executing them is done locally by the authorized user instead of the remote computer.

We also disagree with the examiner (final rejection, page 6) that Orchier provides any teachings related to the parameters associated with the commands for processing the commands. In particular, as stated by Appellants (reply brief, page 6), the maintenance agent of Orchier takes inputs from the user for changes to be made to the database (col. 14, lines 14-17). We also find the Examiner's broad statement (answer, page 7) that processing commands by extracting the parameters associated therewith are well known to be without evidentiary support and mere speculation. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967).

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In view of our analysis above, we find that the Examiner has failed to set forth a *prima facie* case of obviousness with respect to claim 1. We further note that the other independent claims include features related to configuring how the commands execute the modules and processing the command by extracting the parameters associated with the commands, which are absent in the teachings of the applied prior art. Accordingly, the 35 U.S.C. § 103 rejection of claims 1, 4-6, 9, 10, 12, 15-17, 20, 21 and 23-35 cannot be sustained.

We note that the Examiner, in rejecting claims 11 and 22, in addition to Shostack and Orchier, further relies on Smid which neither includes any teachings that read on the disputed claimed features nor provides any suggestion for combining the references to overcome the deficiencies of Shostack and Orchier as discussed above. Accordingly, we do not sustain the 35 U.S.C. § 103 rejections of claims 11 and 22.

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CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 1, 12 and 23-27 under 35 U.S.C. § 112 and claims 1, 4-6, 9-12, 15-17 and 20-35 under 35 U.S.C. § 103 is reversed.

REVERSED



KENNETH W. HAIRSTON

Administrative Patent Judge

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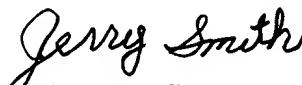
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JERRY SMITH

Administrative Patent Judge

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MAHSHID D. SAADAT

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